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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

7C-9

Office Action Summary

Application No.

09/759,938

Applicant(s)

KIRJAVAINEN ET AL.

Examiner

Hai Vo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 18-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 27-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: ____.

Election/Restrictions

1. Applicant's election of Group I, claims 1-17 and 27-33 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Finland on 08/12/1994. It is noted, however, that applicant has not filed a certified copy of the Finland 943721 application as required by 35 U.S.C. 119(b).

Claim Objections

3. Claim 13 is objected to because of the following informalities: the phrase "characterized in that" needs to be changed to --wherein--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-10, 13-17 and 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, line 8 and claim 14, line 2, the term "like" renders the claims indefinite because the claims include elements

not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language.

The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 13 recites the broad recitation of gas bubbles, and the claim also recites "preferably of a flat shape" which is the narrower statement of the range/limitation.

Regarding claim 16, line 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 27, line 2, the phrase "setting straight" is vague and indefinite because it is unclear whether the film lies flat against a surface or it is an angular orientation of the film to a surface.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirjavainen (US 4,654,546). Kirjavainen teaches a dielectric film made of polypropylene foam and having flat blisters. The film has been charged with a DC field to produce partial discharges in the gas bubbles (column 3, lines 14-16). The film is a swelled dielectric cellular electret film and has been oriented by stretching it in two directions (column 1, lines 33-36). Figure 5b of Kirjavainen discloses a design for producing a surface with sonic activity comprising a cell-type electret film layer **10** and a piezoelectric film layer **13** (analogous to the claimed signal electrode) being provided on the electret film, two amplifiers **15, 16** (analogous to the two claimed ground electrodes) and one controlling acoustic signal **17** (analogous to the claimed signal processing device). The cell-type electret film is made of permanently chargeable and polarizable material (column 5, lines 42-43). Figures 2a and 3a of Kirjavainen show the electret film comprising several layers of film joined together. It is the examiner's position that Kirjavainen anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-14, 17, 27, 28, 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kirjavainen (US 4,654,546). It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Kirjavainen teaches the film lying flat and being coated with an adhesive (figure 1, column 4, line 35). Kirjavainen teaches binding additives (column 5, lines 2-4). Kirjavainen teaches the charge in the film being discharged when the currents on different sides of the film have different directions (column 3, lines 6-9). Kirjavainen is silent as to the dielectric film being self-adhesive. Since the film of Kirjavainen is similar to the film of the present invention, the film having gas bubbles and have been charged with the same means of an electric field to produce a charge inside the film, the charge being discharged when the currents on different sides of the film have different directions. It is the examiner's position that the self-adhesive properties would be inherently present in the film of Kirjavainen. Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (Note discussion found in Ex parte Slob, 157 USPQ 172).

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10. Claims 15, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirjavainen (US 4,654,546) in view of the admitted art. Kirjavainen is silent as to an AC corona treatment of the film surface before charging. At page 1 of the present specification, Applicant admits that it was known to subject dielectric films to AC corona treatment to impart a charge to the film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have subjected the film of Kirjavainen to such a treatment motivated by the desire to provide the desired static charge to the film.

11. Claims 16 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirjavainen (US 4,654,546). Kirjavainen does not specifically disclose ferrochloride being the ferromagnetic powder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ ferrochloride as the binding additives of the dielectric film as taught in Kirjavainen because it is an inexpensive ferromagnetic material which is readily available on the market.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are

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(703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
August 30, 2002



TERREL MORRIS
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